

FORM PTO-1390 (Modified) U.S. PATENT AND TRADEMARK OFFICE; U.S. DEPARTMENT OF COMMERCE

TRANSMITTAL LETTER TO THE UNITED STATES

DESIGNATED/ELECTED OFFICE (DO/EO/US)

CONCERNING A SUBMISSION UNDER 35 U.S.C. 371

ATTORNEY'S DOCKET NUMBER

294227US0X PCT

U.S. APPLICATION NO. (If known, see 37 CFR 1.5)

10/593567

INTERNATIONAL APPLICATION NO.

PCT/EP05/02933

INTERNATIONAL FILING DATE

March 18, 2005

PRIORITY DATE CLAIMED

March 22, 2004

TITLE OF INVENTION

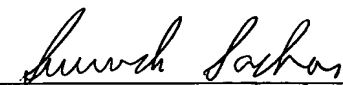
PROCESS FOR PREPARING OPTICALLY ACTIVE AMINO ACIDS USING A WHOLE-CELL CATALYST

APPLICANT(S) FOR DO/EO/US

Harald GROEGER, et al.

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a submission under 35 U.S.C. 371.
 2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a submission under 35 U.S.C. 371.
 3. ☒ This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (24) indicated below.
 4. ☐ The US has been elected (Article 31).
 5. ☒ A copy of the International Application as filed (35 U.S.C. 371(c)(2))
 - a. ☐ is attached hereto (required only if not communicated by the International Bureau).
 - b. ☒ has been communicated by the International Bureau.
 - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
 6. ☐ An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).
 - a. ☐ is attached hereto.
 - b. ☐ has been previously submitted under 35 U.S.C. 154(d)(4).
 7. ☒ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))
 - a. ☐ are attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ have been communicated by the International Bureau.
 - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
 - d. ☒ have not been made and will not be made.
 8. ☐ An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
 9. ☐ An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)).
 - a. ☐ If the declaration is in a language other than the English language, it is accompanied by an English translation. The translation is accurate (37 CFR 1.69)
 10. ☐ An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).
 11. ☐ A copy of the International Preliminary Examination Report (PCT/IPEA/409).
 12. ☒ A copy of the International Search Report (PCT/ISA/210).
- Items 13 to 23 below concern document(s) or information included:**
13. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
 - a. ☐ PTO-1449
 - b. ☐ Cited References
 - c. ☐ Statement of Relevancy
 - d. ☐ List of Related Cases.
 14. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
 15. ☒ A **FIRST** preliminary amendment.
 16. ☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
 17. ☒ An Application Data Sheet under 37 CFR 1.76.
 18. ☐ A substitute specification.
 19. ☐ A power of attorney and/or change of address letter.
 20. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 - 1.825.
 21. ☐ A second copy of the published International Application under 35 U.S.C. 154(d)(4).
 22. ☐ A second copy of the English language translation of the International Application under 35 U.S.C. 154(d)(4).
 23. ☒ Other items or information: Notice of Priority, PCT/IB/304, Request for Consideration of Documents Cited in International Search Report

| | | | | | |
|---|--------------|--|---|-------------------------------|----|
| U.S. APPLICATION NO. (If known, see 37 CFR 1.5) | | INTERNATIONAL APPLICATION NO. | | ATTORNEY'S DOCKET NUMBER | |
| 10/593567 | | PCT/EP05/02933 | | 294227US0X PCT | |
| The following fees are submitted: | | | | CALCULATIONS | |
| | | | | PTO USE ONLY | |
| 24. <input checked="" type="checkbox"/> Basic national fee..... | | \$300 | | \$300.00 | |
| 25. <input checked="" type="checkbox"/> Examination fee If the written opinion prepared by ISA/US or the international preliminary examination report prepared by IPEA/US indicates all claims satisfy provisions of PCT Article 33(1)-(4) \$0 All other situations..... \$200 | | | | \$200.00 | |
| 26. <input checked="" type="checkbox"/> Search fee If the written opinion of the ISA/US or the International preliminary examination report prepared by IPEA/US indicates all claims satisfy provisions of PCT Article 33(1)-(4)..... \$0 Search fee (37 CFR 1.445(a)(2)) has been paid on the international application to the USPTO as an International Searching Authority..... \$100 International Search Report prepared by an ISA other than the US and provided to the Office or previously communicated to the US by the IB \$400 All other situations..... \$500 | | | | \$400.00 | |
| TOTAL OF 24, 25 AND 26 = | | | | \$900.00 | |
| <input type="checkbox"/> Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing or computer program listing filed in an electronic medium). The fee is \$250 for each additional 50 sheets of paper or fraction thereof. | | | | | |
| Total Sheets | Extra Sheets | Number of each additional 50 or fraction thereof (round up to a whole) | RATE | | |
| - 100 = | / 50 = | | x \$250.00 | \$ | |
| <input checked="" type="checkbox"/> Surcharge of \$130.00 for furnishing any of the search fee, examination fee, or the oath or declaration after the date of commencement of the national stage (37 CFR 1.492(h)). | | | | \$130.00 | |
| CLAIMS | NUMBER FILED | NUMBER EXTRA | RATE | | |
| Total claims | 6 - 20 = | 0 | x \$50.00 | \$0.00 | |
| Independent claims | 1 - 3 = | 0 | x \$200.00 | \$0.00 | |
| MULTIPLE DEPENDENT CLAIMS (if applicable) <input type="checkbox"/> + \$360.00 | | | | \$0.00 | |
| TOTAL OF ABOVE CALCULATIONS = | | | | \$1,030.00 | |
| <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Fees above are reduced by 1/2. | | | | | |
| SUBTOTAL = | | | | \$1,030.00 | |
| <input type="checkbox"/> Processing fee of \$130.00 for furnishing the English translation later than 30 months from the earliest claimed priority date (37 CFR 1.492(i)). + | | | | \$ | |
| TOTAL NATIONAL FEE = | | | | \$1,030.00 | |
| <input type="checkbox"/> Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property + | | | | \$ | |
| <input type="checkbox"/> Petition fee of \$1,500.00 for Petition to Revive (37 CFR 1.137 (b)). + | | | | \$ | |
| TOTAL FEES ENCLOSED = | | | | \$1,030.00 | |
| | | | | Amount to be refunded: | \$ |
| | | | | Amount to be charged: | \$ |
| a. <input type="checkbox"/> A check in the amount of \$_____ to cover the above fees is enclosed. | | | | | |
| b. <input type="checkbox"/> Please charge my Deposit Account No. <u>15-0030</u> in the amount of \$_____ to cover the above fees. | | | | | |
| c. <input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. <u>15-0030</u> . A duplicate copy of this sheet is enclosed. | | | | | |
| d. <input checked="" type="checkbox"/> Fees are to be charged to a credit card. WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038. | | | | | |
| NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the International Application to pending status. | | | | | |
| SEND ALL CORRESPONDENCE TO: | | | | | |
| CUSTOMER NUMBER | | | SIGNATURE | | |
| 22850 | | |  | | |
| Tel. (703) 413-3000 | | | Norman F. Oblon | | |
| Fax. (703) 413-2220 | | | Registration No. 34,423 | | |
| (OSMMN 1/06) | | | NAME | | |
| | | | 24,618 | | |
| | | | REGISTRATION NUMBER | | |

10/593567

Docket No. 294227US0X PCT

IAP9/Rec'd PCT/PTO 20 SEP 2006

IN RE APPLICATION OF: Harald GROEGER, et al.

SERIAL NO: New U.S. PCT Application based on PCT/EP2005/02933

FILED: Herewith

FOR: PROCESS FOR PREPARING OPTICALLY ACTIVE AMINO ACIDS USING A WHOLE-CELL CATALYST

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Transmitted herewith is an amendment in the above-identified application.

- ☒ No additional fee is required
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 is claimed.
- ☒ Additional documents filed herewith: Application Data Sheet (3 sheets), Notice of Priority, Credit Card Payment Form for \$1030.00, PCT Transmittal Letter, PCT/IB/304, International Search Report, Request for Consideration of Documents Cited in International Search Report

The Fee has been calculated as shown below:

| CLAIMS | CLAIMS REMAINING | | HIGHEST NUMBER PREVIOUSLY PAID | NO. EXTRA CLAIMS | RATE | CALCULATIONS |
|------------------|---------------------|--|---|---------------------------------|-----------|--------------|
| TOTAL | 6 | MINUS | 20 | 0 | x \$50 = | \$0.00 |
| INDEPENDENT | 1 | MINUS | 3 | 0 | x \$200 = | \$0.00 |
| APPLICATION SIZE | | MINUS | 100 | 0 (each addtl. 50 sheets) | x \$250 = | \$0.00 |
| | | <input type="checkbox"/> MULTIPLE DEPENDENT CLAIMS | | | + \$360 = | \$0.00 |
| | | TOTAL OF ABOVE CALCULATIONS | | | | \$0.00 |
| | | <input type="checkbox"/> Reduction by 50% for filing by Small Entity | | | | \$0.00 |
| | | TOTAL | | | | \$0.00 |

- ☐ A check in the amount of **\$0.00** is attached.
- ☐ Credit card payment form is attached to cover the fees in the amount of **\$0.00**
- ☒ Please charge any additional Fees for the papers being filed herewith and for which no check or credit card payment is enclosed herewith, or credit any overpayment to deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.
- ☒ If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time may be charged to Deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon

Registration No. 24,618

Customer Number

22850

Tel. (703) 413-3000
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(OSMMN 05/03)

Surinder Sachar

Registration No. 34,423

10/593567

IAP9/Rec'd PCT/PTO 20 SEP 2006

DOCKET NO.: 294227 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Harald GROEGER, et al.

SERIAL NO.: NEW U.S. PCT APPLICATION

FILED: HERewith

INTERNATIONAL APPLICATION NO.: PCT/EP05/02933

INTERNATIONAL FILING DATE: March 18, 2005

FOR: PROCESS FOR PREPARING OPTICALLY ACTIVE AMINO ACIDS USING A WHOLE-CELL CATALYST

REQUEST FOR PRIORITY UNDER 35 U.S.C. 119
AND THE INTERNATIONAL CONVENTION

Commissioner for Patents
Alexandria, Virginia 22313

Sir:

In the matter of the above-identified application for patent, notice is hereby given that the applicant claims as priority:

| <u>COUNTRY</u> | <u>APPLICATION NO</u> | <u>DAY/MONTH/YEAR</u> |
|-----------------------|------------------------------|------------------------------|
| Germany | 10 2004 014 280.7 | 22 March 2004 |

Certified copies of the corresponding Convention application(s) were submitted to the International Bureau in PCT Application No. PCT/EP05/02933. Receipt of the certified copy(s) by the International Bureau in a timely manner under PCT Rule 17.1(a) has been acknowledged as evidenced by the attached PCT/IB/304.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618
Surinder Sachar
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10/593567

IAP9/Rec'd PCT/PTO 20 SEP 2006

DOCKET NO.: 294227 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Harald GROEGER, et al.

SERIAL NO.: NEW U.S. PCT APPLICATION

FILED: HERewith

INTERNATIONAL APPLICATION NO.: PCT/EP05/02933

INTERNATIONAL FILING DATE: March 18, 2005

FOR: PROCESS FOR PREPARING OPTICALLY ACTIVE AMINO ACIDS USING A WHOLE-CELL CATALYST

**REQUEST FOR CONSIDERATION OF DOCUMENTS
CITED IN INTERNATIONAL SEARCH REPORT**

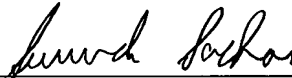
Commissioner for Patents
Alexandria, Virginia 22313

Sir:

In the matter of the above-identified application for patent, notice is hereby given that applicant(s) request that the Examiner consider the documents cited in the International Search Report according to MPEP §609 and so indicate by a statement in the first Office Action that the information has been considered. When the Form PCT/DO/EO/903 indicates both the search report and copies of the documents are present in the national stage file, there is no requirement for the applicant(s) to submit them (1156 O.G. 91 November 23, 1993).

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618
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